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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,557	10/10/2001	W. Monty Reichert	21101.0111U2	7868

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Ballard Spahr Andrews & Ingersoll, LLP
SUITE 1000
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ATLANTA, GA 30309-3915

EXAMINER

RAMILLANO, LORE JANET

ART UNIT	PAPER NUMBER
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1797

MAIL DATE	DELIVERY MODE
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09/04/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/973,557	Applicant(s) REICHERT ET AL.	
	Examiner LORE RAMILLANO	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/23/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-2, 4-7, 13-25, 64-84, 86-89, 93-104, 106-109, and 113-117 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-7, 13-25, 64-84, 86-89, 93-104, 106-109, and 113-117 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Applicant's reply filed on 5/23/08 is acknowledged. Claims 1-2, 4-7, 13-25, 64-84, 86-89, 93-104, 106-109, and 113-117 are pending and are under examination.

Response to Amendment

Allowable Subject Matter

2. The indicated allowability of claims 64-82 is withdrawn in view of the newly discovered reference to Reichert et al. A Double Patenting rejection follows (see below).

Prior art Rejections

3. The rejections over the prior art are withdrawn.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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5. Claims 1-2, 4-7, 13-25, 64-84, 86-89, 93-104, 106-109, and 113-117 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 12 of U.S. Patent No. 5,832,165.

6. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both recite substantially the same subject matter.

In particular, pending claims 1, 64, 83, and 103 recite substantially the same subject matter as recited in the reference patent claim 12 because both comprise the following:

An apparatus for performing a specific bind assay comprising:

a light source disposed to direct light into an optical substrate;

a detection means disposed to detect light from a waveguide;

a waveguide comprising:

a substrate formed of a first optical material of refractive index n_1 and having a surface disposed adjacent and in contact with a waveguide film formed of a second optical material having a refractive index n_2 , which is greater than n_1 ; and a waveguide coupler disposed on the waveguide film;

an input waveguide formed of an optical material having a refractive index n_3 , and having a thickness of between about 0.5 mm and about 5mm; and

a spacing layer formed of an optical material having a refractive index n_4 , wherein $n_4 < n_3$ and $n_4 < n_2$, and having a thickness to optimize evanescent coupling of light from the input waveguide into the waveguide film; and

at least one specific binding molecule immobilized to the waveguide film.

The difference between pending claims 1, 64, 83, and 103 and the reference patent claim 12 are the following:

Reference patent claim 12 does not recite having a sample reservoir. The invention defined in pending claims 1, 64, 83, and 103 would have been an obvious variation of the invention defined in patent claims 12 because the pending application and the reference patent disclose having molecules positioned on the waveguide film. Thus, it would have been obvious variation to incorporate a sample reservoir to the invention disclosed in the reference patent since it would insure that the sample of molecules are securely positioned on the waveguide film.

Despite this obvious variation between the reference patent and pending application, both recite substantially the same subject matter. Therefore, claims 1-2, 4-7, 13-25, 64-84, 86-89, 93-104, 106-109, and 113-117 are fully encompassed by claim 12 of U.S. Patent No. 5,832,165.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LORE RAMILLANO whose telephone number is (571) 272-7420. The examiner can normally be reached on Mon. to Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Samuel P Siefke/
Primary Examiner, Art Unit 1797

Lore Ramillano
Examiner
Art Unit 1797